

REMARKS

The remarks herein are responsive to the Office Action dated July 22, 2003. Claims 1–3, 5–11, and 15–17 are pending. No claims have been amended in this Response.

Claim Rejections Under 35 U.S.C. § 102 (e).

Chang et al.

Claims 1, 3, 5–11, and 15–17 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,391,007 (“Chang et al.”). The Examiner states that “as demonstrated by figure 3c [in Chang et al.], the probe is not completely solid and has a cavity in the middle making it hollow.” Applicant respectfully asserts that claims 1 and 11 recite a bluntable needle assembly comprising a blunting probe, “wherein the blunting probe comprises a hollow tube open only at the ends.” None of the blunts illustrated or described in Chang et al. is “a hollow tube.” To the contrary, the blunts disclosed in Chang et al. are solid blunts (“FIGS. 2A, 2B, 2C, and 2D show cross-sectional views of four examples of solid blunts according to the present invention.” Chang et al. at 2:65–67.). The blunt illustrated in FIG. 3C is the blunt illustrated in FIG. 2C mounted within the shaft of a needle. Chang et al. at 3:1–5.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir.1987). Chang et al. does not describe or suggest a blunting probe comprising a *hollow tube* as recited in claims 1 and 11. Moreover, Chang et al. does not describe or suggest a blunting probe comprising a *hollow tube open only at the ends* as recited in claims 1 and 11. Accordingly, Chang et al. does not recite each and every element found in Applicant’s claims 1 and 11. Applicant submits that the rejections of claims 1 and 11 over Chang et al. are not proper and should be withdrawn. Because claims 3, 5–10, and 15–17 depend on claims 1 and 11 and further recite independently patentable features, Applicant submits that the rejections of these claims over Chang et al. are also not proper and should be withdrawn.

Kinsey et al.

Claims 1, 3, 5–11, and 15–17 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,544,239 (“Kinsey et al.”). Applicant’s claims 1 and 11 recite a bluntable needle assembly comprising a blunting probe, “wherein the blunting probe comprises a hollow tube *open only at the ends.*” Applicant respectfully asserts that Kinsey et al. does not teach or suggest a blunt probe with a rearward open end. Kinsey et al. discloses an apparatus with a blunt 28 (*See Kinsey et al., Fig. 5.*) However, the blunt 28 does not comprise an open rearward end. Instead, fluid exits the blunt through venting port 48, which is disposed away from the end of the blunt. Kinsey et al. at 10:21–25. In other embodiments, the blunt is solid, not hollow. Kinsey et al. at 10:15–17.

As stated above, the Federal Circuit has emphasized that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros.*, 814 F.2d at 631. Consequently, because Kinsey et al. does not describe or suggest a blunt comprising a hollow tube open only at the ends as recited in claims 1 and 11, Applicant submits that the rejections over Kinsey et al. are not proper and should be withdrawn. Because claims 3, 5–10, and 15–17 depend on claims 1 and 11 and further recite independently patentable features, Applicant submits that the rejections of these claims over Kinsey et al. are also not proper and should be withdrawn.

Claim Rejections for Nonstatutory Double Patenting

Claims 1, 3, 5–11, and 15–17 stand rejected under the doctrine of obviousness-double-patenting over claims 1–21 of Kinsey et al. A rejection for obviousness-type double patenting requires factual findings of the *Graham* factors, as provided in MPEP 804(B)(1):

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

Applicant respectfully notes that the Examiner states only that “the current application is a broad version of the same limitations filed in Patent No. 6544239.” Absent the above findings, Applicant submits that the rejection is improper and should be withdrawn.

CONCLUSIONS

For all of the foregoing reasons, Applicant respectfully submits that all of the Examiner's rejections have been overcome and earnestly requests an early allowance of all pending claims. If the Examiner believes that a telephonic conference would expedite the examination of this application, the Examiner is urged to contact the undersigned. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By:



Pui Tong Ho
Reg. No. 44,155
Attorney of Record
Customer No. 20,995
(949) 760-0404